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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,311	02/02/2002	Julie Moriarty	1006.F-5816(MORI 100)	2035

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EXAMINER

KIM, SUN U

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 04/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/066,311

Applicant(s)

MORIARTY ET AL.

Examiner

John Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-15 and 17-22 is/are rejected.
- 7) ☒ Claim(s) 5 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

BEST AVAILABLE COPY**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: _____

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1. Claims 3 and 19 are objected to because of the following informalities: "hemodialysis" on line 6 of claim 3 should be corrected to --hemofiltration--. "or" on line 4 of claim 19 should be corrected to --and--. Appropriate correction is required.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Inlet(s) and outlet(s) are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Without inlet(s) and outlet(s) to the blood processing device to introduce and withdraw blood and/or treated blood products, the blood processing device would not work.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 6-7, 12-14 and 17-18 are and rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,194,145 (hereinafter referred to as Schoendorfer et al '145). Schoendorfer et al '145 teach a blood separation device comprising a blood processing device comprising a gap between outer surface of spinner (22) i.e. claimed inner surface covered by a hemofiltration membrane (40) and inner surface of stationary housing wall (24) i.e. claimed outer surface and a drive mechanism (28) causing Taylor vortices to separate plasma water and

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waste material to be transported to the membrane (40) for transport across the membrane (40) via a plurality of circumferential grooves (42) interconnected by longitudinal grooves (42) forming channels (see figures 1-3; col. 1, lines 9-13; col. 5, line 56 – col. 9, line 20).

6. Claims 1-2, 6-8, 10, 12-14, 17-19 and 21 are and rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,099,730 (hereinafter referred to as Ameer et al). Ameer et al teach a blood separation device comprising a blood processing device comprising a gap between outer surface of rotating inner cylinder (14) i.e. claimed inner surface covered by a hemofiltration membrane (26) and inner surface of stationary outer cylinder (12) i.e. claimed outer surface covered by a hemofiltration membrane (30) and a drive mechanism (22) causing Taylor vortices to separate plasma water and waste material to be transported to the membrane (26, 30) for transport across the membrane (26, 30) (see figures 1-4; col. 4, lines 1-43; col. 6, line 26 – col. 7, line 58).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 9, 11, 15, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ameer et al as applied to claims 1, 8, 12 and 19 above, and further in view of U.S. Patent No. 4,790,942 (hereinafter referred to as Shmidt et al). Ameer et al teach a blood separation device as described in above paragraph. Claims 4, 9, 11, 15, 20 and 22 essentially differ from the apparatus of Ameer et al in reciting a hemodialysis membrane on one surface or on both surfaces and a hemofiltration membrane on one surface and a hemodialysis membrane on the

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other surface. Shmidt et al teach a inner rotating body defining a gap with an outer stationary body wherein the surface of one or both of bodies defining gap being a semi-permeable membrane for ultrafiltration and dialysis wherein the two membranes may be same to increase total effective membrane area or may be different to permit separation of different feed substances (see abstract; figures 1-12; col. 1, lines 10-18; col. 3, line 26 – col. 4, line 1; col. 11, line 26 – col. 12, line 35). It would have been obvious to a person of ordinary skill in the art to modify the apparatus of Ameer et al to substitute a hemodialysis membrane on one surface or on both surfaces for hemofiltration membrane for carrying out hemodialysis with increased effective membrane area or to substitute a hemodialysis membrane on one of surfaces for hemofiltration membrane for carrying out simultaneous hemodialysis and hemofiltration of blood.

9. Claims 5 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 5,000,848 teaches a rotary filtration device with two different membranes.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is (703) 308-2350. The examiner can normally be reached on weekdays from 7:00 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached on (703) 308-0457. The fax phone number for


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official response after final action is (703) 872-9311, and the fax phone number for all other official faxes is (703) 872-9310.

When sending a draft amendment by fax, please mark the paper as "DRAFT"; otherwise, mark the paper "OFFICIAL". This will expedite the processing of the paper.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.


John Kim
Primary Examiner
Art Unit 1723

J. Kim
April 17, 2003

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